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# Supreme Court of the United States

OCTOBER TERM, 1947.

No. [redacted] 16

MANDEL BROTHERS, INC., a corporation,

*Petitioner,*

*vs.*

JOHN H. WALLACE, JR.,

*Respondent.*

## BRIEF FOR PETITIONER.

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# Supreme Court of the United States.

OCTOBER TERM, 1947.

No. 582

MANDEL BROTHERS, INC., a corporation,

*Petitioner,*

*vs.*

JOHN H. WALLACE, JR.,

*Respondent.*

## BRIEF FOR PETITIONER.

### Opinions of the Courts Below.

The opinion of the Seventh Circuit Court of Appeals in this case holding Wallace and Hand patent No. 2,236,387 [R. 167] valid and infringed is reported in 164 F. 2d 861. This opinion reversed the decision of the District Court for the Northern District of Illinois which had held the patent invalid. The opinion of the District Court in this case appears in the record [R. 141].

In the previous case of *Wallace v. F. W. Woolworth Company*, in the District Court for the Eastern District of New York, the trial court held the same Wallace and Hand patent here in suit to be invalid. The opinion of the trial court is reported in 45 F. Supp. 465. The opinion of the Second Circuit Court of Appeals affirming the decision of the trial court is reported in 133 F. 2d 763.

## Jurisdiction.

The opinion of the Seventh Circuit Court of Appeals in this case was filed December 12, 1947 [R. 192], and defendant's petition for rehearing was denied by the Seventh Circuit Court of Appeals on January 6, 1948 [R. 201]. The defendant's petition for certiorari was granted March 15, 1948.

## Statement of the Case.

Respondent sued petitioner in the District Court for the Northern District of Illinois, charging infringement of the Wallace and Hand patent No. 2,236,387 [R. 167]. The trial court held the patent invalid for anticipation and lack of invention. The Circuit Court of Appeals reversed its judgment, finding the patent in suit valid and infringed.

In a previous case of *Wallace v. F. W. Woolworth Company*, in the District Court for the Eastern District of New York, the patent was held invalid by the trial court (45 F. Supp. 465), which judgment was affirmed by the Second Circuit Court of Appeals (133 F. 2d 763); and as will appear later, there is a fundamental disagreement in the legal positions of the two courts of appeals on the question of validity on substantially the same records.

### The Patent in Suit.

The patent in suit is for a composition which is intended to be applied to certain skin areas to inhibit or retard the flow of perspiration. The composition of the patent consists solely of "solutions containing an acid salt of a heavy metal, usually aluminum chloride or aluminum sulfate" [R. 167, col. 1, ll. 5-7) and "a normally neutral water soluble amino compound possessing one or more

intact reactive amino ($NH_2$) groups [R. 167, col. 2, ll. 10-13].

The patent in suit acknowledges [R. 167, col. 1, ll. 3-7] that it had been previously proposed to control the flow of perspiration from certain skin areas by the application of solutions containing an acid salt of a heavy metal, usually aluminum chloride or aluminum sulfate. The patent in suit asserts [R. 167, col. 1, ll. 7 to 12] that, although such prior solutions were effective to retard the flow of perspiration, they tended to be corrosive and irritating to the clothing and skin with which they came in contact.

The patent proposes to add to such otherwise old antiperspirant compositions an amino compound for the sole purpose of inhibiting this corrosive and irritating action of the composition. In the antiperspirant compositions sold by the defendant in this case, as well as by the defendants in the prior case of *Wallace v. F. W. Woolworth Company*, the particular amino compound employed is urea. In fact, the record does not contain any evidence of the utility of any other amino compound except urea. Thus, the sole novelty asserted for the composition of the patent in suit consists in the addition to an otherwise old composition of an amino compound such as urea, for the purpose of retarding the corrosive action of the old composition; and the sole question proposed by the patent in suit is whether it constituted a patentable invention to add an amino compound such as urea to an otherwise old antiperspirant composition, for the purpose of inhibiting the corrosive action of the composition.

As will appear hereafter more fully, all of the antiperspirant compositions which have been marked as made under the patent in suit and the "Ever-Dry" antiperspirant herein alleged to be an infringement of the patent in suit

are in the form of a cream rather than a solution. Furthermore, as will hereafter more fully appear, while the patent in suit speaks of the corrosive character of the prior liquid antiperspirant compositions, no one has found it necessary to add urea or similar substances to a liquid antiperspirant composition to eliminate corrosiveness. It is only where an antiperspirant composition is put out in the form of cream that the practical art has found it of any value to utilize such materials as urea to prevent corrosiveness.

While the patent in suit refers to the prior antiperspirant preparations as "solutions," the composition described in the patent in suit is also a solution. The only specific examples of an antiperspirant composition which appear in the patent in suit contain but three ingredients. These three ingredients are: first, aluminum sulfate; second, urea (first example) or glycine (second example); and third, water [R. 168, col. 1, ll. 20-33]. Nothing is contained in the patent in suit to suggest that the invention is of any particular value as employed in the form of an antiperspirant cream, as distinguished from an antispirant solution. In fact, no information is given in the patent in suit as to how to produce a cream, except the general statement that "Our improved compound may also be incorporated in an emulsion with wax or oil and applied to the skin in this form" [R. 168, col. 1, ll. 37-39].

The patented invention includes not only antiperspirant compositions which contain aluminum sulfate or aluminum chloride as the active antiperspirant ingredients, but the patent also includes antiperspirant compositions in which any metallic salt of a strong acid is employed as an antiperspirant ingredient. It includes salts of such metals "as aluminum, zinc, cerium, zirconium, titanium, iron or

bismuth" and states that "salts of tin, lead and cadmium are also effective" and provides that the acid radical of such salts may include "salts of strong organic acids, such as sulfonic acids" [R. 167, col. 2, ll. 17-24].

Furthermore, the claims of the patent in suit do not define and are not limited to any specific composition. Claims 1, 6, 11, 13 and 16 call broadly for a composition in which any acid reacting inorganic salt of a strong acid may be employed. While claims 2, 3, 4, 5, 12 and 15 recite specifically aluminum sulfate and claim 9 recites specifically aluminum chloride, these claims require only that the composition "comprises" or "includes" aluminum sulfate or aluminum chloride, and thus by their terms include any antiperspirant composition in which, in addition to aluminum sulfate or aluminum chloride, the composition may include other antiperspirant materials. This is illustrated by the fact that the commercial products alleged to be made under the patent in suit, such as "Arrid" and "Fresh" are identified in the record merely as products which include respectively aluminum sulfate [R. 117] and aluminum chloride [R. 117] without any identification of what other acid reacting inorganic salts of a strong acid may be present. Furthermore, these claims have been urged and found to be infringed by defendant's Ever-Dry composition which contains three antiperspirant ingredients in the following proportions, *i. e.*, 7% aluminum sulfocarbolate, 7% aluminum sulfate, and 6.6% aluminum chloride [R. 15]. As will later appear, antiperspirant compositions containing urea, aluminum sulfate and cresol sulfonic acid were in public use and on sale more than two years prior to the application for the patent in suit, it being respondent's position that the invention of the patent in suit arose only when they pro-

duced a preparation omitting the cresol sulfonic acid from the composition. It is therefore to be particularly noted that the patent in suit does not claim any specific composition, but is broadly inclusive of at least any antiperspirant composition which includes, in addition to aluminum sulfate or aluminum chloride, urea; independent of the question of whether or not other effective ingredients are also present in the composition. While claim 7 of the patent in suit specifies a specific composition, this claim is not in suit or alleged to be infringed.

**Public Use and Sale of the Earlier Arrid Containing Cresol Sulfonic Acid, Aluminum Sulfate and Urea.**

The plaintiff and patentee, Wallace, is a manufacturing chemist who in 1932 was doing business under the name of the Wallace Laboratories [R. 113-114]. This continued up to the time of the trial of the case of *Wallace Laboratories v. F. W. Woolworth Company*. Wallace Laboratories has since been incorporated as Wallace Laboratories, Inc., and Wallace is at present vice-president of Wallace Laboratories, Inc. The former Wallace Laboratories developed and manufactured products which were sold by Carter Products, Inc., as a distributor [R. 113].

Previous to 1935 a liquid antiperspirant known as Perstop, which contained aluminum chloride, was manufactured by Wallace Laboratories and sold by Carter Products [R. 120]. Similar liquid antiperspirants have been on the market for some twenty years and sold under the name of "Odorono" [R. 114].

The coinventor of the patent in suit, Hand, was employed by Carter Products in 1935, at which time he and Wallace cooperated together in the investigation of anti-

perspirant compositions [R. 114-115]. Hand conceived of the use of certain cresol sulfonic acids as active antiperspirant ingredients and contemplated marketing an antiperspirant composition containing these materials in the form of a cream. Previous thereto, no antiperspirant composition had ever been marketed in the form of a cream [R. 126]. Wallace and Hand cooperated together in development of this cream. The work of Wallace and Hand on this cream started in the spring of 1935. Immediately they found the cream to be corrosive [Exhibit 9, p. 39]. They at once tried to reduce the acidity by neutralizing with such agents as sodium hydroxide and other strong alkalies [Exhibit 9, pp. 40, 41; R. 128]. When the cresol sulfonic acid was neutralized with sodium hydroxide or other strong alkalies, the corrosive properties were overcome but at the expense of the antiperspirant properties [Exhibit 9, p. 40]. Wallace and Hand then tried urea [Exhibit 9, p. 41; R. 128].

Urea is a well-known chemical compound which was sold in large quantities commercially previous to any alleged invention of the patent in suit. The properties of urea were also well known. The history of the commercial development and properties of urea are fully covered in the two publications, "The Chemistry of Urea" by Werner, defendant's physical Exhibit J, and "Crystal Urea Industrial Development and Properties" by Berliner, defendant's physical Exhibit D. Urea is produced commercially through the reaction of ammonia and carbon dioxide. At ordinary temperatures urea in a solution acts as a weak base or a neutralizer for acids forming addition products thereto [Exhibit D, p. 519]. At more elevated temperatures urea is more completely ionized and therefore active as a stronger neutralizing agent, finally

hydrolizing to give off ammonia [R. 40; see also Exhibit D].

The well-known property of urea to counteract acidity is stated, for example, in Exhibit D, page 518, as follows: "Urea forms additional compounds with acids, acting an as monobasic compound." It required only a simple trial of this well-known weak base to find that it markedly reduced the corrosive action of the cresol sulfonic acid while not reducing the antiperspirant properties as markedly as the sodium hydroxide or stronger alkalies [Exhibit 9, p. 41]. The antiperspirant properties of the cream containing cresol sulfonic acid, however, were considered by Wallace and Hand as insufficient, so to improve the antiperspirant properties they added to the composition aluminum sulfate [R. 124]. By the midsummer of 1935, therefore, Wallace and Hand had produced an antiperspirant composition in the form of a cream which, in addition to cresol sulfonic acid, used urea for the purpose of preventing the corrosive character of the product, and this product also contained aluminum sulfate, aluminum sulfate being present in an amount of about 10% [R. 124]. This material was made by Wallace Laboratories and sold by Carter Products beginning in the midsummer of 1935 and extending until September, 1936 [R. 123]. At least some 30,000 pounds of this material was sold under the trade name of "Arrid" [R. 123].

At the trial petitioner sought to introduce in evidence two advertisements by Carter Products of this earlier Arrid [R. 31, 32, 33, Exhibits A and B], which advertisements show that it was represented that this product was noncorrosive to fabrics. These advertisements were rejected by the trial court on the ground that they were hearsay as to plaintiff Wallace.

Since this earlier Arrid antiperspirant composition was in public use and on sale more than two years prior to the filing on May 3, 1938 of the application for the Wallace and Hand patent in suit [R. 167], the Wallace and Hand patent in suit is totally invalid unless it discloses an invention and is confined to that invention, which invention is separate and distinct from this prior Arrid antiperspirant composition which contained urea and therefore was prior art to the patent in suit.

**The Development of the Later Arrid.**

In September of 1936 Wallace and Hand made one change only in the earlier Arrid which had been in public use and on sale for more than two years. This change consisted merely in omitting the cresol sulfonic acid and increasing correspondingly the amount of aluminum sulfate present [R. 125, 126]. Respondent has taken the position throughout this litigation that the earlier Arrid which contained cresol sulfonic acid, in addition to aluminum sulfate and urea, was not the invention of the patent in suit, and has taken the position that the later Arrid first produced in September, 1936 is patentably distinct from this earlier Arrid material.

In the prior case of *Wallace v. Woolworth*, respondent sought to distinguish the product produced in September, 1936 (omitting the cresol sulfonic acid) from the prior products by so-called conductivity measurements [Exhibit 9, p. 45]. It was asserted that with salts such as aluminum chloride and aluminum sulfate, urea had no appreciable effect on the conductivity, whereas urea when added to cresol sulfonic acid had an increasing effect on the conductivity [Exhibit 9, pp. 45, 46]. This, it was urged, proved that in the composition containing the cresol

sulfonic acid, the urea was all combined with the acid as "urea methylene dicresol sulfonate" [Exhibit 9, p. 45], while the later compositions omitting the cresol sulfonic acid were asserted to have uncombined urea present.

These conductivity tests and the conclusions of respondent relative thereto are not referred to in the patent and were resorted to initially for use in the prior case of *Wallace v. Woolworth*. No corresponding testimony appears in the record of this case. The only testimony in this case relative to such conductivity tests appears in the cross-examination of petitioner and defendant's witness, de Navarre, who testified that these conductivity tests did not justify the conclusions sought to be drawn therefrom by plaintiff and respondent [R. 81]. It is further to be noted that the distinction sought to be made is not in conformity with the language of the patent in suit. The patent in suit points out that the urea or neutral protective ingredient immediately reacts with the acid on its liberation [R. 168, col. 1, ll. 50-56] and, accordingly, proposes the utilization of just the theoretical quantity of urea to combine with the potential acid ion of the salt employed [R. 167, col. 2, l. 55-R. 168, col. 1, ll. 1-19].

Both the records in this case and in the *Woolworth* case show that the cresol sulfonic acid was omitted from the Arrid compound because it was found that it caused the product to darken in color, resulting in discolorization and, moreover, had the effect of generating bad odors [Exhibit 9, pp. 42, 43; R. 124, 125].

To demonstrate the utility of the composition of the patent in suit, plaintiff introduced evidence of certain ironing tests [R. 13-22]. As to these tests, it is to be noted that even without the addition of urea antiperspirant compositions at room temperatures have little corrosive

action on fabrics. It is only under temperatures corresponding to those reached when garments are ironed that urea is of substantial value [R. 19]. The protection afforded by urea, of course, is not complete, as even with the use of urea customer complaints are received [R. 35]. The statement in the patent in suit that the addition of urea reduces the irritating action of the composition on the skin is not supported in the record. In the prior case, District Judge Byers held:

> "As to the part which the urea plays in arresting skin irritation which would result from application of aluminum sulphate alone, the only direct testimony is by the defendant's witness, Dr. Peck, a practicing dermatologist, who says that, except as to persons having specially sensitive skin, there is no irritation so caused. Since that statement was not contradicted, it must be accepted. It is the only medical as distinguished from chemical testimony in the case, and no reason has been shown for disregarding it.
>
> "The utmost that can be said for the contrary theory, as stated at line 10 of page 1 of the specifications of plaintiff's patent, is that skin-irritant property was ascribed to aluminum sulphate (and chloride) in apparent sincerity, and the addition of urea was deemed to be justified, in part at least, to arrest or overcome that tendency. It cannot be said, however, that there is evidence in the case to vindicate the theory." (45 Fed. Supp. 466.)

The record here is the same [R. 18].

**Prior Art Patents Demonstrate That the Power of Urea to Reduce Acidity and Corrosion of Fabrics Was Well Known.**

SHIPP No. 2,174,534 [R. 175].

This patent issued on an application filed earlier than the date of invention alleged for the patent in suit. It discloses a process for parchmentizing fabrics consisting in immersing them for short periods in sulfuric acid baths of varying concentrations and it teaches the use of inhibiting the effect which the acid normally has on the fabrics when used in such a process. The patent states [R. 175, col. 1, ll. 8-14]:

> "It is generally known that concentrated sulfuric acid is destructive to textile materials, nevertheless certain uses of sulfuric acids on textiles are so advantageous that endeavors have been made to so treat textiles with sulfuric acid as to obtain the desired effects but to avoid the undesirable effects."

The patent therefore proposes a process for treating cotton fabrics with sulfuric acid "containing an agent which will inhibit the tendering effect of the acid" [R. 175, col. 1, ll. 6-7].

Shipp employed as useful inhibitors the same type of compounds which are described in the Wallace and Hand patent in suit. The patent not only refers particularly to the use of urea, but gives a full description of the use of the same general class of amides and amino compounds which are described in the Wallace and Hand patent in suit [see Shipp patent R. 178, col. 2, l. 55 through p. 5, l. 25]. For some purposes, the patent also points out that such materials as low molecular weight alcohols and ethers

and ketones may be employed, the patent summarizing by saying [R. 175, col. 2, ll. 1-5]:

> "Now it has been discovered that the degrading effect of the acid on the cellulose may be inhibited or retarded by dissolving in the acid certain agents which are termed inhibitors of cellulose degradation."

The trial court found that the action of urea in the invention of the Shipp patent "is quite like the effect produced by adding urea to a cream or solution containing aluminum chloride or aluminum (sulfate) which is to be applied to the skin or come in contact with the fabric" [R. 149, Finding 26]. This finding of fact is not disturbed in the decision of the Seventh Circuit Court of Appeals here on appeal. The Shipp patent contains a disclosure of a test to be applied to determine whether urea is or is not a suitable inhibitor. This test is as follows [R. 175, col. 2, ll. 22-28]:

> "If a cotton fabric is immersed in 96% sulfuric acid at room temperature, removed immediately and rinsed very quickly with a large volume of water, the fabric is disintegrated and destroyed. However, if as much as 25 parts by weight of urea is first added to each 100 parts of acid, then a fabric may be treated with this solution up to 60 seconds without being appreciably tendered."

This test procedure is erroneously referred to in the decision of the Seventh Circuit Court of Appeals as the Shipp process, the Court of Appeals being under the impression that the Shipp process involved only the use of 96% sulfuric acid. Actually, the Shipp patent discloses the use of acids of widely varying strengths from 65% upwardly [see R. 175, col. 2, ll. 42-44]. In one of the examples

of the process of the Shipp patent, *i. e.*, Example 22, the acid used is not a concentrated acid, but only 70% acid [R. 179, col, 1, ll. 69-74].

In connection with the Shipp patent, the Seventh Circuit Court of Appeals comments on the fact that the patentees of the patent in suit found the old antiperspirant solutions "tended to injure the skin by corrosive action and incidentally damaged the fabric of the clothing of the user" (164 F. 2d, at 865). While the patent in suit states that antiperspirant solutions may be irritating to the skin and suggests that the action of urea is to render such solutions harmless to the skin, the record in the case fails to show any improvement in antiperspirant compositions, so far as the damage to the skin of the user is concerned, by the addition of urea. While at the trial elaborate tests were made of the inhibiting action of urea in preventing the corrosion of fabrics in the matter of irritation of the skin, the record is left merely with the statement of plaintiff's expert, Teller, as follows [R. 18]:

> "Q. 14. Is this matter of irritation a universal matter, or does it occur in only a small proportion of cases?
>
> "A. It is not universal. Some people can use these products without any harm. On the other hand, some people can use them for some length of time without any harm and suddenly become sensitive to them."

In the case of *Wallace v. Woolworth*, the District Court points out that the only direct testimony concerning the part urea plays in arresting skin irritation is that by defendant's Dr. Peck, a practicing dermatologist, who says that "except as to persons having specially sensitive skin, there is no irritation so caused." And the trial court concluded that there was no evidence which would vi-

dicate the theory of the patent in suit that the action of urea had any beneficial effect as far as arresting skin irritation.

The action of urea in the Shipp formula is clearly identical with the action of urea in the patent in suit in so far as its inhibiting action is concerned with respect to the corrosion of fabrics. This is fully supported in the testimony at the trial of defendant's expert, de Navarre [R. 46, 47]. Clearly, the trial court was correct in finding that the Shipp patent entirely anticipated Wallace and Hand in the discovery that urea, when combined with acid, would inhibit the corrosive effect of that acid.

MISSBACH No. 2,069,711 [R. 173].

This patent relates to chlorinated hydrocarbons such, for example, as the familiar carbon tetrachloride which is used for dry cleaning of fabrics. The patent points out [R. 173, col. 1, ll. 4-12]:

> "It is known that these materials when exposed to moisture, light, air, and heat, particularly during distillation, as in the case of carbon tetrachloride, decompose with the formation of substances of an objectionable character, usually acidic substances which render the material unsuitable for such purposes as extractions as well as corroding equipment."

The patent further proposes the addition of urea or related amide, for the purpose of stabilizing the chlorinated hydrocarbon and inhibiting the corrosion action thereof on fabrics. The patent states: "Another object of this invention is to provide an effective corrosion inhibitor for use in the presence of halogenated hydrocarbons" [R. 173, col. 1, ll. 24-28]. The patent therefore proposes the addition of 1% or less of urea and points out

that the materials so employed are selected in view of the intended use of carbon tetrachloride in dry cleaning of clothes [R. 173, col. 1, ll. 37-46]. The explanation offered by Missbach of the inhibiting action of urea is as follows [R. 174, col. 1, ll. 15-21]:

> "The stabilizing effect and inhibiting action in corrosion of my inhibitor toward decomposition of the halogen content is, I believe, accomplished thus:— Firstly, they neutralize or remove any acid or acidic substances present; secondly, they retard the production of acid; thirdly, they form a protective film on the surface of the metal."

In its findings, the trial court points out that the Missbach patent fully describes the action of urea as a corrosion inhibitor to prevent damage to fabrics, but holds that this patent does not teach "that urea will inhibit the corrosive effect while leaving the solution sufficiently acid to be astringent" [R. 149].

While the cleaning fluids described in the Missbach patent may have contained insufficient acidic properties to be effective as antiperspirant material (just as the materials of the Shipp patent contain too much acid to be satisfactory for antiperspirant purposes) the anticipating effect of the Missbach patent should not be dismissed on this ground. The patent in suit contains nothing novel concerning the character of acidic solutions which would be effective as an antiperspirant. This is all old and admittedly well known in the art. The only thing the patent in suit purports to teach as novel is that urea will prevent

the corrosive action on fabrics of such admittedly old acid antiperspirant solutions. Admittedly, Missbach teaches this property of urea. Respondent's expert, Teller, admitted at the trial that the inhibiting action of urea as to the corrosion of fabrics by acid solutions was fully disclosed in Missbach [R. 101]. It required, therefore, no invention but a mere trial to discover that urea would have this same action in an antiperspirant preparation.

Koch No. 2,011,292 [R. 171].

This is another patent illustrating the addition of urea to an acidic preparation used in the treatment of textiles or fabrics to prevent corrosion. The patent discloses that certain solutions of aluminum acetate and aluminum formate are employed in the textile industry and suggests the addition thereto of urea (or related compound) to produce stable solutions. The purpose of this addition of urea is described in the patent in these words [R. 171, col. 1, ll. 38-42]:

> "The solutions of these products may be used with special advantage in the textile industry because they do not contain any substances which would have a detrimental effect when used, for instance, for impregnation purposes."

As explained by defendant's expert, de Navarre, the solutions described in the Koch patent are used in the dyeing of textiles, where a corrosive acidic compound would be objectionable as tending to deteriorate cloth [R. 48]. He points out that the urea in the Koch formula

functions as an acid or corrosion inhibitor just as in the patent in suit [R. 48].

Respondent attempted through its expert, Teller, to distinguish from the Koch patent on the ground that the acetates and formates of aluminum were not corrosive to cloth without urea, and therefore sought to assert that urea was added to obtain some other objective. He testified [R. 103]:

> "Q. 65. If the substances were not harmful to the fabric in themselves, why was it advisable to add urea, in your opinion?
>
> "A. I haven't the faintest idea of what he has been trying to do here, unless it would have some effect on dyes that might be very complicated."

The trial court, because of its reliance on the Shipp patent as showing that the action of urea was well known, did not make finding as to the Koch patent. The New York District Court directly found the Koch patent to disclose the same use of urea to mitigate the acids resulting from the reaction in solutions of aluminum salts as in the patent in suit, and therefore held the patent in suit as displaying no patentable invention over the Koch patent (45 Fed. Supp. 465, 467). The Second Circuit Court likewise reverted to, and evidently relied upon, the Koch patent as disclosing an earlier use of urea as a protective ingredient for fabrics to which a solution might be applied.

## Specification of Errors Relied Upon.

Petitioner relies upon and urges as error the rulings of the Circuit Court below upon the Questions Presented in the Petition for a Writ of Certiorari (p. 6) in this case, which are:

1. Does the patent in suit exhibit patentable invention in the addition of urea to an antiperspirant composition to inhibit corrosion of fabrics in view of the prior knowledge of the power of urea to reduce acidity and its ability to inhibit corrosion of fabrics in the presence of acidity?

2. Is the decision of the Circuit Court of Appeals for the Seventh Circuit in the present case correct in ruling that the patentees are not bound by knowledge in the prior art that urea has the ability to inhibit the corrosion of fabrics in the presence of acid?

3. Are the decisions of the courts in the Second Circuit and of the District Court below in the present case correct that, in view of the prior art knowledge in the textile fabric art of the power of urea to inhibit corrosion, a mere routine experiment to determine that urea will so act in an antiperspirant cream does not involve invention?

4. Was the court below correct in the present case in rejecting the defense of anticipation by the admitted sale and advertisement for sale of the prior Arrid containing urea as not destructive to cloth because such advertisements were not shown to have been written by the patent owners?

## Summary of Argument.

**The Seventh Circuit Court of Appeals Clearly Erred in Holding That the Prior Patents Were in an Art Non-analogous to the Patent in Suit.**

The decision of the Court of Appeals in this case was predicated upon its ruling that Wallace and Hand were not bound by the teachings of the prior art, on the erroneous ground that the prior patents were lacking in analogy to the patent in suit. Wallace and Hand merely added an inhibitor well known as capable of inhibiting the corrosion of fabrics to an otherwise old antiperspirant, merely for the purpose of securing its well known inhibiting action. This was clearly a completely analogous use of the inhibitor, and this case is directly ruled by the decision of this Court in *Dow Chemical Company v. Halliburton Oil Well Cementing Company* (324 U. S. 320, 89 L. Ed. 973).

**The Seventh Circuit Court of Appeals Erred in Not Holding the Patent in Suit Invalid in View of the Public Use and Sale of Antiperspirant Compositions Containing Urea More Than Two Years Before the Filing of the Application for the Patent in Suit.**

The application for the Wallace and Hand patent in suit was filed too late to be within the statutory period for the filing of an application since the extensive sale and use of the early Arrid composition more than two years before the filing of the application for the patent in suit was not experimental and barred the patent in suit.

When Wallace and Hand omitted the cresol sulfonic acid from the earlier Arrid composition and increased

correspondingly the percentage of aluminum sulfate, they did not make any invention patentable over the earlier Arrid composition. The patent in suit covers broadly the use of an amino compound such as urea and includes the earlier Arrid as well as the later Arrid composition, and is therefore void as not filed within the statutory period.

**The Wallace and Hand Patent in Suit Does Not Exhibit the Exercise of the Inventive Faculties.**

No exercise of the inventive faculties but merely the ordinary skill of a chemist is involved in producing the composition of the patent in suit. Not only was the property of urea to protect textiles against acid well known in the textile art, but it was part of the common knowledge of chemists. It was admittedly known to Wallace and Hand before they undertook to produce the patented composition. They at once adopted and used urea when they found a corrosion problem arising in their attempt to produce an antiperspirant cream—substantially contemporaneously therewith the same solution was provided by others.

Nothing more than a simple trial was required to establish the value of urea in an antiperspirant cream. This trial merely confirmed what any chemist would have expected to occur. The law does not permit a conclusion that invention is involved by a mere routine trial of this class which leads to no new or unexpected result.

**Long Felt Want and Commercial Success.**

This is not a case involving any long felt want.

## ARGUMENT.

### The Seventh Circuit Court of Appeals Clearly Erred in Holding that the Prior Patents were in an Art Non-analogous to the Patent in Suit.

In holding the patent invalid, the District Court for the Eastern District of New York (*Wallace v. F. W. Woolworth Company*, 45 Fed. Supp. 465) found that the action of urea to inhibit the effect of strong acid salts upon textile fabrics was known in the prior art, particularly in the prior art patent to Koch No. 2,011,292 [R. 171]. The District Court found that, in view of this knowledge, no invention was involved in conceiving that a similar action would be effected by the addition of urea to an otherwise old antiperspirant composition.

In affirming the decision of the District Court for the Eastern District of New York, the Circuit Court of Appeals for the Second Circuit (133 F. 2d 763) found that the property of urea to protect textiles against acids was well known in the art and was, in fact, known to the patentee Wallace before he began any work to inhibit the corrosive action of an antiperspirant on clothing.

It was found that the prior patents to Shipp No. 2,174,534 [R. 175] and Koch No. 2,011,292 [R. 171] each taught that urea had the ability to inhibit deleterious effects of acids on fabrics. It concluded that no invention, but a mere routine laboratory experiment, was involved in the patentee's testing of urea to find that urea would do the same thing in an antiperspirant composition, stating (133 F. 2d at 764):

> "This is a typical case of patient experiment to achieve a useful result. There was no long felt want. As soon as an astringent was used to check perspira-

tion, the acidity of which proved to be excessive, urea was the neutral protective ingredient that about the same time occurred to Wallace, Hand, Killian and Montenier and even before them was known by chemists to protect textiles against acids, as is shown by the patents to Shipp and Koch."

In its decision in the present case, the District Court for the Northern District of Illinois, Eastern Division [R. 141], based its conclusion that the patent was invalid on the finding that the prior patent to Shipp "anticipated Wallace and Hand in the discovery of the peculiar effect of urea when combined with an acid" [R. 143], and that nothing patentable was involved in conducting a simple experiment to establish that urea would have this action in an antiperspirant cream [R. 144].

In reversing the decision of the District Court in the present case, the Court of Appeals for the Seventh Circuit expresses no disagreement with these findings of the District Court for the Eastern District of New York, the District Court for the Northern District of Illinois, or the Second Circuit Court of Appeals, to the effect that the property of urea to reduce acidity and to inhibit the corrosive action of acidic materials on textile fabrics was well known in the prior art. The Court of Appeals for the Seventh Circuit predicates its decision in this case on the erroneous ground that the textile arts, in which this property of urea was well known, is nonanalogous to the art of producing antiperspirant compositions. The Seventh Circuit Court of Appeals in this case predicates its decision on an erroneous statement of a rule of patent law, to the effect that the patentees of the patent in suit

were not bound by what was known or shown in the textile arts, stating [164 F. 2d at 863; R. 195]:

> "It is obviously necessary to determine whether the references lie within the confines of the prior art by which Wallace and Hand were bound, or whether they lie in an art lacking in analogy to antiperspirants."

Consistent with this finding, the court held [164 F. 2d at 865; R. 198]:

> "It would seem obvious from the foregoing announcements that the District Court erred in its conclusion that the patentees were bound by the teachings of the prior art of Shipp."

This decision of the Seventh Circuit Court of Appeals was clearly an error. When it became apparent to Wallace and Hand that their antiperspirant composition in the form of a cream was corrosive to fabrics, it is axiomatic that the logical place to look for a solution of such a problem was in the art of handling fabrics. To hold that Wallace and Hand, when they found that a cream was corrosive to fabrics, were not bound by what was known in the art of handling fabrics to prevent corrosion is not only clearly illogical and unsound, but directly contrary to the latest decision on this subject by this Court.

In *Dow Chemical Company v. Halliburton Oil Well Cementing Company* (324 U. S. 320 at 327, 89 L. Ed. 973, at 979) this court held:

> "All the Grebe-Sanford process taught was the obvious fact that hydrochloric acid could be inhibited to prevent corrosion while being used to dissolve limestone rock pursuant to the Frasch method of acidizing wells. * * * No new or unexpected

results were obtained by the addition of such an inhibitor. It was perfectly plain to an expert that the metal well equipment would thereby be protected from corrosion. The Grebe-Sanford method, in short, involved in this respect no more than a mere application of an old process of inhibition to a new and analogous use of protecting metal well equipment from corrosion when the well is being acidized to increase production. Such a process lacks the very essence of an invention."

In the *Dow v. Halliburton* case, the particular inhibitors used by the Grebe-Sanford patent were arsenic compounds. Such inhibitors had been used extensively in the commercial pickling of iron and steel products in acid solutions, and in the transportation of acids in metal containers.

The analogy between the facts of the *Dow v. Halliburton* case and the case at bar is clear. In the *Dow v. Halliburton* case the process of acidizing a well without the use of an inhibitor was old in the art. In the case at bar the antiperspirant solutions of the patent in suit omitting the inhibitor were old and well known in the art. In *Dow v. Halliburton* the arsenic compounds employed as inhibitors in the patent in suit were well known in the iron and steel art, whereas, in the case at bar the inhibitor of the patent in suit, urea (and related compounds), was well known in the art of treating and cleaning fabrics.

The Wallace and Hand patent, in short, involves no more than a mere application of the old process of inhibition of fabrics by the use of urea to the new and analogous use of inhibiting corrosion of fabrics in the utilization of antiperspirant compositions. No new and unexpected results were obtained by the addition of such an inhibitor.

In the *Dow v. Halliburton* case the rule was applied, although some 36 years elapsed between the issue of the Frasch patent in 1898 disclosing the acidizing process and the issue of the Grebe-Sanford patent in 1932 disclosing the addition of the inhibiting compounds. In the present case, the adoption of urea to inhibit the corrosion of fabrics followed substantially immediately as soon as it was found that antiperspirant compositions in the form of a cream were corrosive to fabrics, and the record shows that the same idea of using urea to prevent corrosion of fabrics and in antiperspirant compositions occurred substantially simultaneously to others.

In support of its decision that the use of urea as an acid inhibitor in an antiperspirant composition was non-analogous to the use of urea as an acid inhibitor in the art of handling fabrics, the Seventh Circuit Court of Appeals relies principally on decisions of the Seventh Circuit such as *A. J. Deer Co. Inc. v. U. S. Slicing Machine Co.*, 21 F. 2d 812, and *Copeman Laboratories Co. v. General Plastics Corporation*, 149 F. 2d 962, but makes a most obvious misapplication of the language even of these decisions. In *A. J. Deer Co. Inc. v. U. S. Slicing Machine Co.*, the court states (21 F. 2d at 813):

> "We are of opinion that whether arts or uses are analogous depends upon the similarity of their elements and purposes. If the elements and purposes in one art are related and similar to those in another art, and because and by reason of that relation and similarity make an appeal to the mind of a person

having mechanical skill and knowledge of the purposes of the other art, then we are of opinion that such arts must be said to be analogous, and, if the converse is true, they are nonanalogous arts."

Clearly; in the present case the elements under consideration are acidic solutions and urea as an inhibitor of the action of those acidic solutions on fabrics. The similarity of the elements and the similarity of the purposes of the inhibitor is complete. Certainly no chemist familiar with the use of urea for inhibiting the corrosion of fabrics in the fabric art, as shown, for example, by the Shipp patent, the Koch patent and the Missbach patent, would fail to receive a suggestion that urea would accomplish the same purpose in an antiperspirant composition. This Court in *Cuno Engineering Corp. v. Automatic Devices Corp.*, 314 U. S. 84 at 91, 86 L. Ed. 58 at 63, stated:

"A new application of an old device may not be patented if the 'result claimed as new is the same in character as the original result' (Blake v. San Francisco, 113 US 679, 683, 28 L ed 1070, 1072, 5 S Ct 692) even though the new result had not before been contemplated. Pennsylvania R. Co. v. Locomotive Engine Safety Truck Co., 110 US 490, 494, 28 L ed 222, 223, 4 S Ct 220 and cases cited."

In this case the inhibiting agent, urea, has only this old purpose and effect of reducing the corrosive action of the acid incident to its contact with fabrics; it has no effect upon the action of the acid in retarding the flow of perspiration.

In *Grinnell Washing Mach. Co. v. Johnson Co.*, 247 U. S. 426 at 432-4, 62 L. Ed. 1196 at 1199, this Court states:

> "* * * Merely bringing old devices into juxtaposition, and there allowing each to work out its own effect without the production of something novel, is not invention. No one by bringing together several old devices without producing a new and useful result, the joint product of the elements of the combination and something more than an aggregate of old results, can acquire a right to prevent others from using the same devices, either singly or in other combinations, or, even if a new and useful result is obtained, can prevent others from using some of the devices, omitting others, in combination.' Hailes v. Van Wormer, *supra*. (20 Wall. 353, 368)."

Having quoted this statement of this general principle, this Court in that case proceeds (247 U. S. at 433, 62 L. Ed. at 1200) to further clarify it:

> "Applying the rule thus authoritatively settled by this court, we think no invention is shown in assembling these old elements for the purposes declared. No new function is 'evolved from this combination;' the new result, so far as one is achieved, is only that which arises from the well-known operation of each one of the elements."

*Germer Stove Co. v. Art Stove Co.*, 150 Fed. 141 at 145 (C. C. A. 6), applied this rule of want of invention, saying:

> "Germer has done no more in his first claim than to unite the Condit fire pot with a grate in which the

amount of air might be controlled by a damper. There is nothing new in his fire pot, for it is the fire pot of Condit. There is no invention in his grate, for grates in which the supply of air may be regulated were not new. The claim covers a mere aggregation of elements, the fire pot and the fire grate each producing its own effect after as before the combination, each operating in the combination as it did before. The mere bringing together of old parts and allowing each to work out its own old effect, without producing some new product or result as a consequent of the union and co-operating action, is a mere mechanical juxtaposition. Goodyear Tire & Rubber Co. v. Rubber Tire Wheel Co., 116 Fed. 363, 370, 53 C. C. A. 583; Overweight Counterbalance Elevator Co. v. Henry Voight Mach. Co., 102 Fed. 957, 43 C. C. A. 80."

Respondent cannot be aided here by stressing the fact that urea was first used in an antiperspirant composition. As stated by this Court in *Dow v. Halliburton* (342 U. S. 320 at 328, 89 L. Ed. 973 at 980):

"He who is merely the first to utilize the existing fund of public knowledge for new and obvious purposes must be satisfied with whatever fame, personal satisfaction or commercial success he may be able to achieve. Patent monopolies, with all their significant economic and social consequences, are not reserved for those who contribute so insubstantially to that fund of public knowledge."

**The Seventh Circuit Court of Appeals Erred in Not Holding the Patent in Suit Invalid in View of the Public Use and Sale of Antiperspirant Compositions Containing Urea More Than Two Years Before the Filing of the Application for the Patent in Suit.**

Congress has in express terms limited the inventions for which a patent may be obtained by an inventor to those "not in public use or on sale in this country * * * more than two years* prior to his application"( 35 U. S. C. §31). Accordingly, if an invention has been in public use or on sale in this country more than two years prior to the application, the right to obtain a patent is lost. (*Root v. Third Ave. R. Co.,* 146 U. S. 210, 36 L. Ed. 946; *Andrews v. Hovey,* 123 U. S. 267, 31 L. Ed. 160; *Smith, & Griggs Mfg. Co. v. Sprague,* 123 U. S. 249, 31 L. Ed. 141; *Manning v. Cape Ann Isinglass, etc. Co.,* 108 U. S. 462, 27 L. Ed. 793; *Hall v. Macneale,* 107 U. S. 90, 27 L. Ed. 367; *Worley v. Loker Tobacco Co.,* 104 U. S. 340, 26 L. Ed. 821; *Egbert v. Lippmann,* 104 U. S. 333, 26 L. Ed. 755; *Elizabeth v. American Nicholson Pav. Co.,* 97 U. S. 126, 24 L. Ed. 1000; *Consolidated Fruit Jar Co. v. Wright,* 94 U. S. 92, 24 L. Ed. 68; *McClurg v. Kingsland,* 1 How. (U. S.) 202, 11 L. Ed. 102.)

Use of an invention by or under control of the inventor for the purpose of determining whether the invention is complete or requires modification or change before final adoption does not place the invention in public use within the meaning of the statute. (*Smith & Griggs Mfg. Co. v. Sprague,* 123 U. S. 249, 31 L. Ed. 141; *Beedle v. Bennet,*

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*Amended by Act of Aug. 5, 1939, 53 Stat. 1212, to read "one year" instead of two years.

122 U. S. 71, 30 L. Ed. 1074; *Elizabeth v. American Nicholson Pav. Co.*, 97 U. S. 126, 24 L. Ed. 1000; *Kendall v. Winsor*, 21 How. (U. S.) 322, 16 L. Ed. 165.) To come within this rule, the main purpose of the use must be to enable the inventor to determine whether the invention is complete or requires modification or change before final adoption (*Smith & Griggs Mfg. Co. v. Sprague*, 123 U. S. 249, 31 L. Ed. 141). The rule has no application where the use, although originally for the purpose of experiment, is continued for a longer period than is reasonably necessary to determine whether the invention is complete or requires further modification or change. (*Root v. Third Ave. R. Co.*, 146 U. S. 210, 36 L. Ed. 946; *Manning v. Cape Ann Isinglass, etc., Co.*, 108 U. S. 462, 27 L. Ed. 793; *Hall v. Macneale*, 107 U. S. 90, 27 L. Ed. 367; *Worley v. Loker Tobacco Co.*, 104 U. S. 340, 26 L. Ed. 821.) To bring a use or sale within the exception made in favor of experimental use or sale, there must be evidence both of the need and of the fact of experimentation, and the burden of proof is upon the patentee to establish that the public use or sale was experimental within the exception to the rule (*Grand Rapids Showcase Co. v. Measuregraph Co.*, 28 F. 2d 497 (C. C. A. 8)), the presumption being that the use or sale is not experimental (*American Ballast Co. v. Davy Burnt Clay Ballast Co.*, 220 Fed. 890).

> "The thing implied as excepted out of the prohibition of the statute is a use which may be properly characterized as substantially for purposes of experiment. Where the substantial use is not for that purpose, but is otherwise public, and for more than two years prior to the application, it comes within the prohibition." (*Smith & Griggs Mfg. Co. v. Sprague*, 123 U. S. 249, 31 L. Ed. 141 at 143.)

"That it was capable of improvement need not be denied, nor that, while it was in daily use, its owner and inventor watched it with the view of devising means to meet and overcome imperfections in its operation; but this much can be said in every such case. There are few machines, probably, which are not susceptible of further development and improvement, and the ingenuity of mechanics and inventors is commonly on the alert to discover defects and invent remedies. The alterations made in the machine in question, however useful, were not vital to its organization. Without them, it could and did work so as to be commercially successful." (*Id.*, 31 L. Ed. at 146-7.)

Clearly the Seventh Circuit Court of Appeals erred in dismissing this defense on the ground that the sale of the antiperspirant composition containing 10% aluminum sulfate, urea and cresol sulfonic acid and cream forming constituents [R. 124] by Wallace and Hand was merely experimental. Some 30,000 pounds of this material were sold by Carter Products beginning in the summer of 1935 and extending until September, 1936 [R. 123]. The advertisements of Carter Products relative to this material were rejected by the trial court as not the advertisements of the plaintiff Wallace. Yet, it was ruled that these sales by Carter Products were the mere experiments of the inventors, Wallace and Hand. There is no evidence in the record and there was no attempt made by plaintiff at the trial to show that the purpose of these sales was for experimentation. This is not a case where there was a single use or a single sale, but a continued succession of sales in the ordinary course of business, with the sole motive of obtaining the profits ordinarily derived from

trade. Clearly, under the authorities given above, the anticipating effect of this earlier Arrid material on the patent in suit should not be dismissed on the ground that it was a mere experimental use.

Nor does the record sustain the decision of the Seventh Circuit Court of Appeals that the evidence concerning the prior use and sale of this earlier Arrid material was largely excluded by the trial court. On the contrary, as we have shown, the facts appear uncontradicted in the testimony of the plaintiff himself. The only evidence excluded was the offered advertisements of Carter Products. Even if, despite the close connection between Carter Products and the plaintiff and patentee as shown by the record, the trial court was correct in finding such advertisements were hearsay as regards Wallace, the defense is completely established. The advertisements were offered merely to show that it was represented that these materials were noncorrosive. It may well be that the later products were less corrosive, but the undisputed facts in the evidence are that urea was added to this earlier composition to reduce the corrosive action and that, in fact, it did reduce the corrosive action.

Clearly, if there were any invention to be made over the prior patent art in conceiving that urea was useful to prevent corrosion of fabrics in antiperspirant compositions, this invention was embodied in this earlier Arrid antiperspirant composition and, therefore, such invention cannot be utilized to sustain the patent in suit. All that was done in September, 1936 by Wallace and Hand was merely to omit the cresol sulfonic acid and increase the percentage of aluminum sulfate from 10 to 20. If this change constituted an invention, it certainly was not the discovery of the value of urea and, moreover, it is not

the invention described or sought to be patentable in the patent in suit. The patent in suit is predicated on the broad statement that the objects of the invention of the patent are carried out by the addition of an amino compound, such as urea, to any heavy metal salt of a strong acid [R. 167, col. 2, ll. 7-13]. The patent is not limited to antiperspirant compositions containing as the sole ingredient aluminum sulfate as distinguished from antiperspirant compositions containing sulfonic acids as well as aluminum sulfate. In fact, the patent expressly states: "* * * salts of strong organic acids, such as sulfonic acids, may also be used" [R. 167, col. 2, ll. 23-24]. Thus, the patent by its own terms expressly includes the earlier Arrid composition in public use and on sale more than two years before the application was filed.

Furthermore, the claims of the patent in suit are broadly inclusive. Claims 1, 6, 11, 13, 14 and 16 in suit cover broadly any acid reacting inorganic salt of a strong acid, while claims 2, 3, 4, 5, 12, and 15 recite specifically aluminum sulfate, and claim 9 recites specifically aluminum chloride. These claims cover any compound which comprises or includes aluminum sulfate or aluminum chloride, and thus by their terms cover compositions in which, in addition to aluminum sulfate, the antiperspirant preparation includes metallic salts of sulfonic acids. This is illustrated by the fact that the composition of petitioner, which is herein held to constitute an infringement of each and all of the claims in suit, contains 7% aluminum sulfocarbolate, 7% aluminum sulfate, and 6.6% aluminum chloride [R. 15]. Thus petitioner's antiperspirant composition contains less aluminum sulfate than the early Arrid in public use and on sale more than two years before the filing of the patent in suit.

Clearly the invention attributed to the patent in suit by the Seventh Circuit Court of Appeals, and the only invention described in the patent in suit, was in public use and on public sale by the patentees more than two years before they applied for the patent in suit, and the patent is therefore void.

**The Wallace and Hand Patent in Suit does not Exhibit the Exercise of Inventive Faculties.**

In order to sustain the patent in suit, it is not only necessary that the subject matter of the patent be novel, but it is further necessary that the production of that subject matter require the exercise of the inventive faculties as distinguished from mere ordinary chemical skill. No such invention was involved in producing the patented composition.

The property of urea to protect textiles against corrosion from acid was not only well known in the textile art, as shown by the prior patents to Koch, Shipp and Missbach, but this property of urea was the common knowledge of all ordinarily skilled chemists. Even if Wallace and Hand had been the first discoverers of this property of urea they could not have patented it (*Funk Bros. Seed Co. v. Kalo Inoculant Co.*, 92 L. Ed. Ad. Op. 414, decided by this Court February 16, 1948). The record shows that before they made any test at all on the use of urea, the patentees were fully familiar with this property of urea [R. 127]. In the *Woolworth* case the witness for the plaintiff, Killian, likewise showed that this property of urea was one well known to the ordinary chemist [Exhibit 9, pp. 27, 28]. As soon as Wallace and Hand experimented with an antiperspirant cream that was corrosive, the thought of using urea to prevent that

corrosion substantially immediately occurred to them. It likewise substantially contemporaneously occurred to others. The proceedings in the Patent Office leading to the grant of the patent in suit shows that before it was granted an interference was declared between the application for Wallace and Hand and applications of two other persons, Jules B. Montenier and W. Kedzie Teller [Exhibit 9, pp. 318-319].

This Court has repeatedly held that where substantially as soon as a problem arises the same expediency is used to solve that problem, not only by the patentee, but substantially contemporaneously by others, such facts establish that mere mechanical or chemical skill, as distinguished from invention, is involved in the adoption of such an expediency. Thus in *Concrete Appliances Company v. Gomery*, 269 U. S. 177 at 185, 70 L. Ed. 222 at 226-7, this Court held:

> "It is but 'the suggestion of that common experience, which arose spontaneously and by a necessity of human reasoning, in the minds of those who had become acquainted with the circumstances with which they had to deal.' Hollister v. Benedict Mfg. Co., 113 U. S. 59, 72, 28 L. ed. 901, 905, 5 Sup. Ct. Rep. 717. This progressive adaptation, much of which preceded and some of which was co-temporaneous with the Callahan adaptation, of well known devices to new but similar uses, 'is but the display of the expected skill of the calling, and involves only the exercise of the ordinary faculties of reasoning upon the materials supplied by a special knowledge, and the facility of manipulation which results from its habitual and intelligent practice.' Hollister v. Benedict Mfg. Co., *supra*, at page 73 (28 L. ed. 905, 5 Sup. Ct. Rep. 717). No novel elements were used by Callahan in

his device. We are unable to find that their use in combination in it was more than the application to them of mechanical skill in the course of a mutual development and expansion of the art."

The Second Circuit Court of Appeals was clearly correct in holding in the *Woolworth* case (133 F. 2d at 764):

"This is a typical case of patient experiment to achieve a useful result. There was no long felt want. As soon as an astringent was used to check persipration, the acidity of which proved to be excessive, urea was the neutral protective ingredient that about the same time occurred to Wallace, Hand, Killian and Montenier, and even before them was known by chemists to protect textiles against acid, as is shown by the patents to Shipp and Koch."

Not only had the thought of using urea occurred to the patentees Wallace and Hand substantially immediately after they found that their antiperspirant cream was corrosive, but once this thought had occurred to them it required merely a trial to find that urea accomplished the purpose. This trial led to no new discovery nor to any unexpected result. Wallace and Hand by this trial merely confirmed what the ordinary routine knowledge of the chemist led them to expect would occur. Inventions do not arise by any such process. The mere routine work of an investigator involving no imagination does not constitute invention. This rule is well illustrated by the decision of the Second Circuit Court of Appeals in this case and the decisions therein cited. The Second Circuit Court of Appeals was clearly correct in holding (133 F. 2d at 764):

"We have repeatedly held that skillful experiments in a laboratory, in cases where the principles of the

investigations are well known, and the achievement of the desired end requires routine work rather than imagination, do not involve invention. Ruben Condenser Co. v. Aerovox Corporation, 2 Cir., 77 F. 2d 266, 267; Ruben Condenser Co. v. Copeland Refrigeration Corp., 2 Cir., 85 F. 2d 537, 541; Fink v. V. Foscato, Inc., 2 Cir., 79 F. 2d 842, 843; Claude Neon Lights, Inc., v. Rainbow Light, Inc., 2 Cir., 90 F. 2d 959, 962."

When Wallace and Hand were led by their previous knowledge of the properties of urea to expect that as applied to antiperspirant compositions these same properties would be useful, they clearly merely confirmed in a routine manner (by a process well known to all chemists) what they had already anticipated. They made no discovery, the process involved no imagination or no exercise of the inventive powers. It cannot therefore be said that the patent in suit involves any invention.

**Long Felt Want and Commercial Success.**

Evidence that a machine, process or composition of matter has fulfilled a long felt want or need and was commercially successful may be referred to only if all the other proof in the case leaves the question of invention in doubt. In *Slip Scarf Co. v. Wm. Filene's Sons Co.*, 289 Fed 641, the First Circuit Court of Appeals affirmed the refusal of the trial court to give requests Nos. 20 and 21, relating to the jury's taking into consideration, on the question of invention, the difficulties existing before the invention that were overcome by the patented invention, that it filled a want not adequately filled before, that it became public and went into extensive use, that the trade acquiesced in the patent by taking licenses, etc.,

and that others had tried and failed to meet the difficulties, saying, at 649:

> "The rule is that the class of evidence above referred to is to be made use of in determining the question of invention only in a doubtful case. Duer v. Corbin Cabinet Co., 149 U. S. 216, 13 Sup. Ct. 850, 37 L. Ed. 707; McClain v. Ortmayer, 141 U. S. 419, 429, 12 Sup. Ct. 76, 35 L. Ed. 800; American Salesbook Co. v. Carter-Crume Co. (C. C.) 125 Fed. 499."

Here the question is not open to doubt. There is no evidence in the record here that will sustain a finding that the composition of the patent in suit fulfilled any long felt want. This is not a case involving a long felt want but quite the opposite thereto. It is a case where a problem was immediately solved as soon as it arose. Wallace and Hand were the first to attempt to market an antiperspirant cream [R. 126]. Only the antiperspirant creams marketed have used urea to prevent corrosion. As we have shown, within a very short period of time after finding antiperspirant creams produced corrosion, urea was adopted by Wallace and Hand and substantially contemporaneously by others. The Court of Appeals in the *Woolworth* case quite correctly ruled: "There was no long felt want."

In this case the Court of Appeals held [R. 193]:

> "In this respect, the evidence is convincing that Wallace's composition was tremendously successful commercially. We think, too, that the evidence discloses clearly an existing public demand for a compound possessing the desirable qualities mentioned and a fulfillment of that demand by the patented product."

There is no evidence in the record which can sustain this conclusion of the Court of Appeals. The record

shows that for some twenty years previous to the patent in suit liquid antiperspirant compositions were successfully marketed without using any such material as urea to prevent corrosion, and that subsequent to the patent in suit they continued in successful competition with the patent in suit, such products being even sold by Carter Products up through the time of the trial of the case below.

The patentee, Wallace, testified [R. 119, 120]:

"XQ 79. In the anti-perspirant Perstop to which you have referred, you relied upon aluminum chloride as the astringent constituent, is that correct?

"A. We did.

"XQ 80. There was no urea incorporated?

"A. There was not.

"XQ 81. That was in stick form?

"A. Perstop was a solution of aluminum chloride.

"XQ 82. Typical of those which had been used before generally in the art?

"A. Yes.

* * * * * * * * *

"XQ 85. Over what period of time?

"A. I believe it has been on the market since 1934.

"XQ 86. And is still on the market?

"A. It is still on the market.

"XQ 87. And it is being sold by Carter Products?

"A. It is.

"XQ 88. As an anti-perspirant liquid?

"A. Yes.

"XQ 89. That contains no urea?

"A. It contains no urea.

"XQ 90. Is there any so-called protective ingredient incorporated in Perstop?

"A. There is not."

There is no evidence in the record that anyone familiar with the liquid antiperspirant compositions on the market previous to the alleged invention of the patent in suit ever found any necessity for reducing the corrosive character of those compositions or ever tried to so do or ever failed in trying to so do. There is no evidence in the record that anyone having knowledge of these prior antiperspirant compositions and knowledge of the use of urea as an inhibitor of the corrosive action ever attempted to, or failed to successfully produce an antiperspirant composition in which urea was used to reduce the corrosive character of such antiperspirant compositions. In the absence of such proof, the doctrine of fulfillment of a long felt want is not applicable to these cases. To bring a case within the doctrine of long felt want, it is necessary to show that those familiar with the relative prior art were unable to solve the existing problem. As said by this Court in *Toledo Pressed Steel Co. v. Standard Parts*, 307 U. S. 350 at 356, 83 L. Ed. 1334 at 1338: "But it does not appear that either was familiar with the relevant prior art."

Patentable novelty, originality or invention cannot be ascribed to the use of that which was in fact public knowledge. The long commercial sale of such liquid antiperspirant compositions as Perstop and Odorono [R. 114] has made these antiperspirant compositions part of the public knowledge. The prior patents to Shipp, Koch and Missbach had made the use of urea as an inhibitor part of the public knowledge. Lack of knowledge of these patents and publications cannot remove them from the

public domain. Nor would the fact, if true, that Wallace and Hand were ignorant of these prior patents make them the original and first inventors thereof under the patent statute. Their invention was anticipated because it was part of the public knowledge.

> "Bone may have been ignorant of them and his device may not have been their suggestion. They seem to have been unknown to American engineers, not even the interest of the controversy in the sixth circuit having developed their existence. From this local ignorance nothing can be deduced favorable to the patent. Its device having been described in printed publications, although in foreign countries, patentable novelty or originality cannot be asserted for it. Rev. Stat. Sec. 4886, Act of March 3, 1897, 29 Stat. at L. 692, chap. 391, Comp. Stat. Sec. 9430, 7 Fed. Stat. Anno. 2d ed. p. 23. Such is the provision of the law, and we cannot relax it in indulgence to what may seem the individual's merit." (*Bone v. Marion County*, 251 U. S. 134 at 144, 64 L. Ed. 188 at 193.)

See further *Tashjian v. Forderer Cornice Works*, 14 F. 2d 414, 415 (C. C. A. 9); *Ironclad Mfg. Co. v. Dairyman's Mfg. Co.*, 143 Fed. 512, 513 (C. C. A. 2); *Fry v. Rookwood Pottery Co.*, 90 Fed. 494.

> "Entirely irrespective of the matter of use, a man is not entitled to the reward given inventive genius, if his invention had theretofore been disclosed to the public through the public records of the Patent Office. The statute rewards invention, and not diligence in unearthing prior patents which have not been turned

into commercial success." (*W. H. Butcher Packing Co. v. Cincinnati B. S. Co.*, 35 F. 2d 567 at 569 (C. C. A. 10).)

Although the proof established that the Simmons patented method actually filled a long felt want (Cf. 98 F. 2d 436 at 439-40), this Court, in *Honolulu Oil Corp. v. Halliburton*, 306 U. S. 550 at 554, 562, 83 L. Ed. 980 at 983, 987, held the Simmons patent anticipated by the Franklin patent, although there was no proof that anyone had ever used the Franklin device for the performance of the Simmons method and although the description in the Franklin patent was "to control flow and not to test productivity of strata reached before completion of wells (p. 562). This Court said of the Franklin device:

> "Plainly, it may be used as a tester; for by its use the contents of the producing stratum, sealed off from the rest of the well and unimpeded in its entry into the rat-hole by pressure of the rotary mud, can be brought undiluted to the surface by a mechanism almost duplicating that shown by the patent in suit." (p. 554.)

In the case at bar—as it did in the *Woolworth* case—plaintiff stresses commercial success of the method practised by plaintiff as evidence that invention was required to produce the composition of the patent in suit. Commercial success is not proof of invention. (*Lempco Products v. Timken*, 110 F. 2d 307 (C. C. A. 6); *American Fruit Growers v. Brogdex*, 283 U. S. 1, 75 L. Ed. 801; *Bulldog Elec. Prod. Co. v. General Elec. Co.*, 105

F. 2d 466, 468-9 (C. C. A. 4).) The commercial success of the composition of the patent in suit was due to the preference of the trade for a product in the form of a cream and to the extensive advertisements thereof [R. 125, 131]. All that plaintiff has established is that he has sold large quantities of the composition of the patent in suit by means of extensive advertisements. Urea was the natural buffer to add to reduce the corrosion of acidic antiperspirant compositions [Exhibit 9, p. 26]. These properties are well known.

> "Articles of manufacture may be new in the commercial sense when they are not new in the sense of the patent law." (*Union Paper Collar Co. v. Van Deusen,* 23 Wall. 530, 23 L. Ed. 128 at 133.) "The fact that the patented article has gone into general use is evidence of its utility, but not conclusive of that, and still less of its patentable novelty. *McClain v. Ortmayer,* 141 U. S. 419, 425 (35:800, 802) and authorities there cited." (*Grant v. Walter,* 148 U. S. 547 at 556, 37 L. Ed. 552 and 557.)
>
> "Nevertheless commercial success is an unsafe guide to invention unless prior efforts to fill the space be shown (National, etc., Co. v. Bissell, etc., Co., 249 Fed. 196, 161 C. C. A. 232); and when they are shown, it is not infrequently found that the faculty of invention was not necessary to fill whatever vacancy existed." (*Boston Pencil Pointer Co. v. Automatic Pencil Sharpener Co.,* 276 Fed. 910 at 911-12 (C. C. A. 2).)

## Conclusion.

It is respectfully submitted that the decision of the Seventh Circuit Court of Appeals sustaining the patent in suit on the ground that the patentees were not bound by the prior knowledge of the properties of urea in the fabric art was clearly erroneous and that the patent in suit should be declared invalid upon the ground that the use of urea to prevent corrosion of fabric was merely a well known expedient in the art, and for the further reason that the application for the patent was not filed within the statutory period.

Respectfully submitted,

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